

Serial No. 10/051,073
Docket No. 2001P014480

10

REMARKS

Claims 1-21 are all of the claims presently pending in the application. Claim 1 has been amended to more particularly define the claimed invention.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner that would require further consideration and/or search.

It is noted that the claim amendments are made only for more particularly pointing out the claimed invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claims.

Applicant gratefully acknowledges the Examiner's indication that claims 9-13 and 19-21 are allowed. However, Applicant submits that all of claims 1-21 should be allowed.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura (U.S. Patent No. 6,243,563). Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by JP No. 09-46110 to Wataya Masafumi (hereinafter "JP '110"). Claims 2-7 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of JP '110.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a portable telephone set including a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals, a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit provided in a second housing for demodulating the radio signal from the switch (e.g., see Application at page 5, lines 16-25).

The claimed invention (e.g., as defined by exemplary claim 8) is directed to a portable telephone set including a radio circuit for demodulating a radio signal received by an antenna and transmitted via a cable, and a battery for supplying power to the radio circuit, wherein the battery and the radio circuit are interconnected by the cable, and wherein power from the

Serial No. 10/051,073
Docket No. 2001P014480

11

battery is supplied via the cable to the radio circuit (e.g., see Application at page 8, lines 7-14).

The claimed invention, of exemplary claims 1 and 8, provides a portable telephone capable of efficient inter-housing transmission of radio signals (see Application at page 5, lines 12-15). Furthermore, the claimed invention provides a portable telephone set with reduced size and weight (see Application at page 5, lines 9-11).

II. THE REJECTIONS BASED ON PRIOR ART REFERENCES

A. Claim 1

The Examiner alleges that Nakamura teaches the claimed invention of claim 1. Applicant submits, however, that there are elements of the claimed invention, which are neither taught nor suggested by Nakamura.

That is, Nakamura does not teach or suggest *"a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one; and a radio circuit provided in a second housing for demodulating the radio signal from the switch"*, as recited by exemplary claim 1.

The Examiner attempts to rely on Figure 2 and column 3, lines 10-39 of Nakamura to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Nakamura teach or suggest a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit provided in a second housing for demodulating the radio signal from the switch. Indeed, the Examiner does not even allege that Nakamura teaches or suggest this feature.

That is, Nakamura does not even teach a device having a first housing and second housing, let alone teach or suggest that the switch is disposed in a first housing and the radio circuit is disposed in a second housing, as recited by the claimed invention. Furthermore, the Examiner, in his rejection of claims 2-7 and 14-18, concedes that Nakamura does not teach that the switch is provided in a first housing and the radio circuit is provided in the second housing (see Office Action dated November 2, 2005 at page 5).

Therefore, Applicant respectfully submits that there are elements of the claimed invention that are neither taught nor suggested by Nakamura. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Serial No. 10/051,073
Docket No. 2001P014480

12

B. Claim 8

The Examiner alleges that JP '110 teaches the claimed invention of claim 8. Applicant submits, however, that there are elements of the claimed invention, which are neither taught nor suggested by JP '110.

That is, JP '110 does not teach or suggest "*wherein power from the battery is supplied via the cable to the radio circuit*", as recited by claim 8.

The Examiner attempts to rely on Figure 1 of JP '110 to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in Figure 1 (nor anywhere else for that matter) does JP '110 teach or suggest that power from the battery is supplied via the cable to the radio circuit. Indeed, JP '110 merely teaches transmitting power from a power supply section (9) through a coaxial cable (32) to a high frequency amplifier (7) (see JP '110 at Abstract).

That is, as best understood, the "radio circuit for demodulating the radio signal" in JP '110 is located in the main body 3 ("...and the amplified signal is fed to a receiver of the telephone set main body 3"). Thus, the configuration shown in JP '110 falls to satisfy the plain meaning of the claim language, since the battery (B) and the power supply circuit (23) are also located in the main body 3.

The Examiner attempts to rely on the power supply section (9) as teaching the battery, for supplying power to the circuit for demodulating the radio signal (which the Examiner alleges is taught by the receiver (21)). However, the Examiner continues to mischaracterize the features of JP '110. That is, JP '110 clearly provides a battery (B), which is provided in the same lower housing as the receiver (21), which the Examiner relies upon as teaching the radio circuit (see JP '110 at Figure 1). Therefore, in JP '110, the battery (B) and the radio circuit (21) are clearly provided in the same housing. Therefore, the battery (B) does not provide power to the receiver (21) through the coaxial cable (32).

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggested by JP '110. Therefore, the Examiner is respectfully requested to withdraw this rejection.

Serial No. 10/051,073
Docket No. 2001P014480

13

C. Claims 2-7 and 14-18

The Examiner alleges that JP '110 would have been combined with Nakamura to form the claimed invention of claims 2-7 and 14-18. Applicant submits, however, that, even if combined, the alleged combination of references would not teach or suggest each and every element of the claimed invention.

That is, neither JP '110, nor Nakamura, nor any combination thereof, teaches or suggests *"a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity on; and a radio circuit provided in a second housing for demodulating the radio signal from the switch"* as recited in claim 1, and similarly recited in claims 2-5.

Indeed, as detailed in section A above, Nakamura does not teach or suggest this feature. Furthermore, Applicant submits that JP '110 fails to make up the deficiencies of Nakamura.

The Examiner alleges that JP '110 teaches a switch provided in a first housing, a radio circuit provided in a second housing and that the switch and the radio circuit are connected by a cable. The Examiner attempts to rely on Figure 1, items 18, 21, 22 and 32, of JP '110 to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this Figure (nor anywhere else for that matter) does JP '110 teach or suggest a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit provided in a second housing for demodulating the radio signal from the switch. Indeed, features 18, 21 and 22, which the Examiner relies upon to support his allegations, are all located in the same housing.

Indeed, the output control (18; which the Examiner analogizes to the claimed switch) and the receivers (21 and 22; which the Examiner analogizes to the claimed radio circuit) are clearly disposed in the same housing of the wireless device (see JP '110 at Figure 1). Therefore, the switch (18) and the radio circuit (21/22) are clearly not provided in separate housings, as recited in the claimed invention. Furthermore, since the switch (18) and the radio circuit (21/22) are provided in the same housing, they are not connected by the cable (32).

Therefore, Applicant respectfully submits that these references, even if combined, would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Serial No. 10/051,073
Docket No. 2001P014480

14

III. FORMAL MATTERS AND CONCLUSION

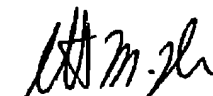
In view of the foregoing, Applicant submits that claims 1-21, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: January 19, 2006



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY LAW
GROUP, PLLC**
Intellectual Property Law
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

FACSIMILE TRANSMISSION

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2682, at (571) 273-8300, on January 19, 2006.

Date: January 19, 2006

Respectfully Submitted,



Scott M. Tulino, Esq.
Reg. No. 48,317

Sean M. McGinn, Esq.
Reg. No. 34,386